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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,265	09/10/2003	Raymond Poynor	20003.0067	4006

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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT PAPER NUMBER

3711

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/658,265

Applicant(s)

POYNOR, RAYMOND

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34-41 is/are allowed.
- 6) ☒ Claim(s) 26-31, 33 and 42-45 is/are rejected.
- 7) ☒ Claim(s) 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

This Office action is responsive to communication received 07/07/2004 – Amendment.

Claims 26-45 remain pending.

Claims 34-41 STAND allowable over the prior art of record.

Claim 32 STAND objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim.

Following is an action on the MERITS:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26-31, 33 and 42-45 STANDS rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda in view of Funk, as stated in the last Office action, mailed 04/07/2004.

RESPONSE TO ARGUMENTS

In the arguments received 07/07/2004, the applicant contends that the claimed invention defines over the combination of applied prior art references because the prior art references either singularly or in combination fail to show, suggest or otherwise render obvious the use of a peening operation for treating the inner surface of a metal wood golf club head. The applicant argues that the primary reference to Takeda is

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directed to a cavity back club head, noting that such club heads are commonly recognized as "iron" club heads and that the present claimed invention in contrast is directed to a metal "wood" golf club head. In addition, the applicant argues that both Takeda and the further applied teaching to Funk fail to show treating of the inner surface of a club face and that impermissible hindsight has been used to combine these references.

In response to the arguments, it is noted that while Takeda mentions that his invention is particular to iron-type club heads, there is nothing in Takeda that excludes the interpretation of the invention as it applies to "wood" type club heads. In fact, the claims in Takeda are broadly drawn to a "golf club incorporating a head" without specific reference to a cavity back iron head. Though the applicant argues that the language "cavity back" is associated with clubs of the "iron" type, it is clear that such an interpretation is not absolute. For example, the reference to Wilson, now of record, describes a "wood" type club head of the cavity back design. The Wilson reference pictorially details a cavity back club head that is similar to the club head shown in Takeda, yet references the club head as a "wood". Thus, it is clear that the terminology used in Takeda when describing a cavity back club head does not absolutely refer only to iron-type club heads. Here, the Wilson patent is cited for explanation purposes only and is not to be interpreted as introducing a different or new interpretation of the grounds of rejection of record (see MPEP §2131.01). Even if one were to persuasively argue that the Takeda device is clearly directed to an iron-type club head and not a metal wood club head, as intended by the applicant, it is clear that the extension of the

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Takeda teaching to cover other clubs commonly used by a golfer would have been obvious. For example, a set of clubs commonly draws on the same inventive concept for providing all of the clubs in the set, both irons and woods, with the benefits of a particular advance in the art – perhaps a common groove configuration or a similar perimeter weighting configuration. Here, a set of golf clubs is used for explanation purposes only and is not to be interpreted as introducing a different or new interpretation of the grounds of rejection of record (see MPEP §2131.01). Concerning the combination of Takeda and Funk, it is noted that Takeda already contemplates the possibility of a shot blasting process on the interior of the cavity (col. 4, lines 58-65). Takeda notes that the use of the cover (17) eliminates the need for sand blasting. However, if one were to remove the cover element in Takeda, which is used solely for aesthetic purposes, the skilled artisan would have been motivated by Takeda itself to use a sand blasting operation to remove the unsightly cutter marks. Funk simply provides the added motivation to use a shot peening process to treat the surface of a club head, thus obviating the use of shot peening in the golf club head art. As both shot peening and sand blasting are impact treatment processes used to enhance the performance of a workpiece, the selection of shot peening over sand blasting would have been obvious to the skilled artisan based upon the metal used for the workpiece and the degree of metallurgical microstructural change that is desired.

No claim is allowed.

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sebastiano Passaniti
Primary Examiner
Art Unit 3711

S.Passaniti/sp
December 6, 2004